

**REMARKS**

The Examiner rejected claim 16 under 35 U.S.C. § 101 as being directed to non-statutory subject matter, contending that a rewritable file format is directed to an abstract idea not tied to a technological art, environment, or machine. Independent claim 16 has been amended to claim a rewritable digital file rather than a file format. A rewritable digital file is statutory subject matter because it is a tangible, defined product that can be copied, modified, bought and sold, etc. Therefore, the applicant respectfully requests that the rejection of claim 16 under 35 U.S.C. § 101 be withdrawn.

The Examiner rejected claims 6-8 under 35 U.S.C. § 102(b) as being anticipated by Windows Explorer. The Examiner's rejection is improper as Windows Explorer does not disclose all claim limitations of these respective claims, as amended. Specifically, independent claim 6 includes the limitations of (1) maintaining a list of a plurality of user-selected image content for a user; (2) determining potential desirable additional image content for the user based upon the list free from additional image content being selected by the user; and (3) indicating to the user the potential desirability of adding additional image content without requiring interruption of the user's work flow with a decision operation to be made by the user before the user continuing with the work flow. Windows Explorer only discloses the first of these cited limitations, but not the latter two.

To support the existing rejection, the Examiner has included screenshots showing (1) the Examiner first viewing a list of image content relating to folder 09823219; (2) the Examiner opening from folder 09500449 a list of image content relating to a completely separate matter; (3) copying an image from that latter list and (4) pasting it into the former list. While the initial list of image content for the present application qualifies as "a list of a plurality of user-selected image content for a user", the remainder of the Examiner's demonstration does not show any of the other limitations.



First, the ability of the Examiner to open a folder that contains images for an unrelated matter certainly does not show the claimed limitation of “determining potential additional image content for said user *based upon said list*.” The Examiner failed to explain how the list of image content in folder 09823219 was the basis for the Examiner determining that the content of folder 09500449 was potential desirable additional image content for the user. Instead, the Examiner’s selection of this latter folder appears to be completely arbitrary, and not based on anything, let alone the list of image content in folder 09823219. In addition, the new folder selected by the Examiner in Windows Explorer, apparently at random, fails to meet the additional claimed limitation of being free from the additional image content being selected by the user. In direct contrast, the additional image content in Windows Explorer is explicitly selected by the Examiner.

With respect to the third limitation, the Examiner has failed to show that *Windows Explorer* indicated to him that he should copy a file from folder 09500449 to folder 09823219 and has failed to show the desirability of doing so, since Windows Explorer has no means of knowing what, if any, relationship the two folders have with each other. In fact, to applicant’s knowledge, these two folders each pertain to images entirely unrelated to one another, and there would be no desirability at all in copying an image from one into the other. Accordingly, the claimed limitation of “indicating to said user the potential desirability of adding...” is absent from Windows Explorer reference.

In addition, the copying operation from one folder to another and selecting the paste operation, as described by the Examiner, required an interruption in the work flow of whatever other process was being performed. Accordingly, the claimed limitation of “without requiring interruption of the user’s work flow with a decision operation to be made by said user before continuing with said work flow” is similarly lacking from the Windows Explorer reference.

For the foregoing reasons, independent claim 6 patentably distinguishes over Windows Explorer.



Claims 7 and 8 depend from claim 6 and are patentable for the same reasons asserted for claim 6.

The Examiner rejected claims 10-16 under 35 U.S.C. § 102(b) as being anticipated by Echerer et al., U.S. Patent No. 5,740,267.

Echerer et al. disclose an apparatus and method for storing image files of patient X-rays or other radiographs in which original scanned image data is maintained in an unmodified image file while any modifications or enhancements to the original image are stored separately in an analysis file. See, Echerer et al, column 7 lines 21-29 and column 9 lines 24-36. The disclosed motivation for Echerer et al's apparatus is to preserve the original image quality, which may be degraded by successive image modifications. Though the system of Echerer stores modified image data in a separate file, Echerer discloses an alternate embodiment where the "analysis file is attached to the image file . . . to insure that the analysis files are never separated from the image." See, Echerer et al., column 9 lines 49-55.

Based upon the disclosure of Echerer et al, the applicant has canceled claims 10-15.

Independent claim 16, as amended, includes the limitations of "a pixel data portion for preserving original image data in a first file format free from modification when said file in said rewritable image format is rewritten and a meta-data portion containing rewritable instructions for rendering said pixel data portion in a second file format." These limitations are supported in the specification at pp. 3 and 6.

Echerer et al. does not disclose this limitation, but is instead limited to storing instructions, in a file separate from image data in a particular file format, for making modifications to the image data in that file format. The system of Echerer et al. does not disclose that the "analysis file" includes instructions for converting the format of the image file to a new file format. Therefore, independent claim 16, as amended, patentably distinguishes over Echerer et al. and should be allowable.

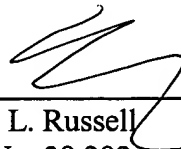
In view of the foregoing amendments and remarks, the Applicant respectfully requests reconsideration and allowance of claims 6-8 and 16.



Appl. No. 09/823,219  
Amdt. Dated September 15, 2005  
Reply to Office Action dated April 6, 2005

Applicant submits herewith a Petition for a three month extension of time, together with the requisite fee. If it is deemed that additional fees are required for the submission of this Amendment, the Commissioner is hereby authorized to charge said fees to Deposit Account No. 03-1550.

Respectfully submitted,

  
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Kevin L. Russell  
Reg. No. 38,292  
Tel No.: (503) 227-5631

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria VA, 22313-1450.

Dated: September 15, 2005

  
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Kevin L. Russell